

REMARKS

Claims 1-9 are pending in this application. Claims 1, 7, and 9 have been amended.

In the Office Action, claims 1-9 were provisionally rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/765,274. Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over previously cited U.S. Publication 2002/0018218 (Conheady) in view of previously cited U.S. Patent No. 5,626,026 (Mian) and newly cited U.S. Patent No. 5,485,406 (Wada). These rejections are respectfully traversed. Applicant hereby respectfully requests reconsideration and allowance of the claims in view of the following arguments.

Regarding the provisional rejection of claims 1-9 on the ground of nonstatutory obviousness type double patenting, a terminal disclaimer was filed on November 9, 2006 to overcome this rejection. However, the Examiner points out that the terminal disclaimer was not signed by a person of record in this case. A new terminal disclaimer has been filed, which has been properly signed by a person of record. Applicant believes the terminal disclaimer is fully responsive to the Examiner's concerns, and is sufficient to overcome the double patenting rejection.

Regarding the obviousness rejection of claims 1-9 based on Conheady, Mian and Wada, independent claims 1, 7 and 9 have been amended for clarity to recite that the surface of the tire is scanned *while the wheel is rotating*. This amendment is fully supported, for example, at paragraph 0017 of the present application. No new matter has been added.

It would not have been obvious to combine the three cited references to yield the inventions of amended claims 1, 7 and 9, at least because none of the three cited references teaches or suggests scanning the surface of a tire while the wheel is rotating. The primary

Conheady reference does not teach or suggest scanning the surface of a tire, and does not teach or suggest scanning while the wheel is rotating. There would be no reason for Conheady's device to do this, since its purpose is to determine the contour of the inside of a wheel rim (see paragraph 0029 of Conheady). In fact, contrary to the contentions in the Office Action, Conheady does not even disclose the claimed rotary angle sensor coupled to the shaft on which the wheel is mounted (or the corresponding claimed step of measuring a rotary angle position of the wheel). As explained at paragraph 0034 of Conheady, its rotary angle sensor 9 is for measuring the position of its *stepping motor 10* that pivots a light source 6 and a receiver 7, not for measuring the angular position of a *tire*, as claimed.

The secondary Mian reference is silent on whether the tire 110 shown in its tread-measuring apparatus of Fig. 15 is rotated while it is being scanned. The secondary Wada reference, although it teaches a tire rotary angle sensor 6, *teaches away* from the claimed apparatus/step of scanning the surface of a tire while the tire is rotating. At col. 6:26-43, Wada explains that a tire 4 is rotated to a desired position, then the measuring unit 7 is moved toward the tire 4 until stoppers 21 contact the tire 4 to fix the distance from the tire surface to the detection means 10 of the measuring unit 7. Thus, Wada's tire 4 is measured by measuring unit 7 when its wheel is stationary.

None of the Conheady, Mian or Wada references teaches or suggests the step of scanning the surface of a tire while the wheel is rotating of amended independent method claims 1 and 9, or the light source and receiver of amended independent claim 7 that scan a tire and receive reflected signals from the tire while the wheel is rotating. Therefore, any combination of these three references, however made, would still be missing this important claimed feature. Moreover, it would not have been obvious to modify any Conheady/Mian/Wada combination to

yield the inventions of amended claims 1, 7, or 9; at least because, as discussed hereinabove, the Wada reference teaches away from scanning the surface of a tire while the wheel is rotating, and the other two references do not teach or suggest this claimed feature at all.

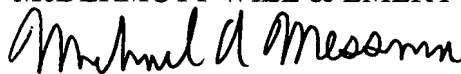
Consequently, amended claims 1, 7 and 9 are patentable, as are claims 2-6 and 8, which depend from claims 1 and 7, respectively.

Having fully responded to all matters raised in the Office Action, Applicant submits that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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